

DOCKET NO.: 219507US-2S DIV

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

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Hideo ANDO et al.

: EXAMINER:

NOV 15 2002

SERIAL NO: 10/076,284

: DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

FILED: February 19, 2002

: GROUP ART UNIT: 2615

FOR: INFORMATION STORAGE SYSTEM
CAPABLE OF RECORDING AND
PLAYING BACK A PLURALITY OF
STILL PICTURES

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AUG 09 2002

Technology Center 2600

PETITION TO MAKE SPECIAL UNDER MPEP § 708.02(VIII)

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

I. Basis for the Petition

Pursuant to MPEP § 708.02(VIII) (8th ed. 2001), Applicants hereby petition for a special status for this Application.

II. Requirements for Granting Special Status

MPEP § 708.02(VIII) established five requirements for a grant of special status. The following subsections show that each of these five requirements is satisfied in the above-

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A. Submit Petition and Fee: § 708.01(VIII)(A)

This petition is accompanied by the fee set forth in 37 C.F.R. § 1.17(h).

Docket No.: 219507US-2S DIV

ASSISTANT COMMISSIONER FOR PATENTS

RE: Application Serial No.: 10/076,284

Applicants: Hideo ANDO et al.

Filing Date: February 19, 2002

For: INFORMATION STORAGE
SYSTEM....

Group Art Unit: 2615

Examiner: Not Yet Assigned

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SIR.

Attached hereto for filing is the following paper:

Technology Center 2600

**Petition to Make Special Under MPEP § 708.02(VIII);
Information Disclosure Statement; Form PTO-1449; Cited References (7);
Explanations of Circumstances Concerning Accelerated Examination for Japanese Patent
Application No.'s 1999-25612, 1998-192063 and 1999-256210
(Japanese Petitions with English Translation) (3).**

Our check in the amount of -130.00- is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted document, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the above-listed document timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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B. Agree to an Election Without Traverse: § 708.02(VIII)(B)

Applicants submit that Claims 28-32, presented by Preliminary Amendment on February 1, 2002, are directed to a single, patentable invention. If a restriction requirement is imposed in this Application, Applicants agree to elect Claims 28-30 without traverse.

C. State that a Preexamination Search was Made: § 708.02(VIII)(C)

Searches were conducted by group art unit 2615 of the Patent and Trademark Office in cases related to the claimed subject matter of the present application (i.e., same patent family). These cases are:

- application Serial No. 09/630,430, filed on August 1, 2000
(now U.S. Patent 6,360,056 to Ando et al., hereinafter Ando '056);
- application Serial No. 09/348,267, filed on July 7, 1999
(now U.S. Patent 6,353,702 to Ando et al., hereinafter Ando '702); and
- application Serial No. 09/476,777, filed on December 30, 1999
(now U.S. Patent 6,389,222 to Ando et al., hereinafter Ando '222).

The search records indicate that searches in these related U.S. applications were conducted in the following classes/subclasses: 386/46, 95, 96, 105, 120, 121, 125, and 126 along with H04N 5/91. The references identified by the Patent and Trademark Office as relevant in these three cases are made of record in the Information Disclosure Statement filed herewith.

Applicants submit that the claimed subject matter of the present application is substantially similar in scope to that of the parent Ando '056 and grandparent Ando '702 application, in that the grandparent Ando '056 application claims, in relevant part, an information storage system capable of recording and playing back a plurality of still pictures,

while the Parent application claims, in relevant part, an information storage medium used for recording and playing back a plurality of still pictures.

Further, Applicants conducted supplemental searches of the PATOLIS (Patent Online Information System) for Applicants' related Japanese applications 1998-192063, 1999-265210, and 2002-87033 to identify other prior art that may not have been found in the above-identified searches. Results of these supplemental searches are identified in Applicants' petitions for accelerated examination submitted to the Japanese Patent Office for the above-listed related Japanese applications. Translated copies of these Japanese petitions are filed herewith. The search methodology used for the supplemental searches entailed the use of the following keywords play list/user-defined PGC, entry point, primary text, item text, movie AV file information, still picture video object group, time map information, VOBU entry, management information, moving and still. The field of search included all Japanese Patent and Utility models from January 1990 to March 26, 2002.

Applicants' respectfully submit these U.S. and supplemental searches qualify as a pre-examination search for the present application as the search methodology entailed searching by keyword and patent class in accordance with the subject matter of the disclosure.

D. Submit a Copy of the Most Relevant References: § 708.02(VIII)(D)

Heretofore unfiled references cited in the Applicants' supplemental searches along with heretofore unidentified references cited in the parent Ando '056, grandparent Ando '807 and sibling Ando '222 U.S. applications are included in the Information Disclosure Statement (IDS) attached hereto. Translated copies of the Japanese patent publications 11-136613, 9-182013, 8-205014, and 5-158778 are also filed via the attached IDS. Translated copies of Japanese patent publications 7-143429 and 5-165935 are being produced and will be filed via a supplemental IDS forthwith. English and Japanese copies of the Japanese petitions for

accelerated examination, including summaries of prior art found, are also filed via the attached IDS.

E. Submit a Detailed Discussion of the References, Pointing Out How the Claimed Subject Matter is Patentable Over the References: § 708.02(VIII)(E)

Consistent with the searches discussed above, Applicants respectfully submit that the claims of the parent application patentably distinguish over all of the references now of record. A detailed discussion pursuant to 37 C.F.R. § 1.111 is provided below, pointing out how the claimed subject matter is patentable over the references of record.

Independent Claim 28 is directed to, in relevant part, an information storage medium for use with at least one of a data recording device and a playback device, the information storage medium comprising:

“...at least one first information unit configured to store at least one piece of still picture information and control information corresponding to one still picture; and

 a first group unit configured to store information corresponding to at least one of said at least one first information unit, said one piece of still picture information being recorded in said first group unit,...”

Furthermore, the control information includes at least one search pointer (S_VOGI_SRP) describing a start address of video object group information (S_VOGI) and at least one video object information for picture object (S_VOGI). The video object information for picture objects (S_VOGI) includes a still picture video object entry (S_VOB_ENT) which contains information for accessing objects including pictures, while the video object information for picture objects (S_VOGI) includes information of an address of a first still picture (S_VOG_SA) and a size of a picture. Claims 29-30 depend from Claim 28.

Independent Claims 31 and 32 are directed to methods for recording information on and playing back information from, respectively, the storage medium claimed in independent Claim 28.

Claims 28-32 comprise features similar to features contained in Claims 16-20 which were canceled in the grandparent application Serial No. 09/348,267 (Ando '702) by way of an amendment filed on February 28, 2001. In an Office Action dated November, 29, 2000, Claims 16-20 of grandparent application Serial No. 09/348,267 (Ando '702) were rejected under 35 U.S.C. § 112, second paragraph as being indefinite, Claims 16-18 were rejected under 35 U.S.C. § 101 as being directed towards non-statutory subject matter, Claims 16-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Sawabe et al. (6,148,138), and Claims 16-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Oguro et al. (5,712,947). Applicants' traversal of these rejections was presented in Applicants' Supplemental Preliminary Amendment filed in this case on April 19, 2002.

Regarding the references associated with the U.S. and supplemental searches, the following comments apply:

Japanese Patent Application KOKAI Publication No. 5-165935 (hereinafter JP '935), cited in Applicants' Supplemental IDS filed herewith, describes image signals recorded in an IC memory card where associated image management data is grouped and classified (see e.g. paragraph [0072]) and then recorded in a large scale memory 26 (see e.g., paragraph [0082]).

Japanese Patent Application KOKAI Publication No. 11-136613 (hereinafter JP '613), cited in Applicants' Supplemental IDS filed herewith, describes an image recording device capable of quickly retrieving undesired recording data while recording a moving image on a recording medium capable of being accessed at random.

Japanese Patent Application KOKAI Publication No. 9-182013 (hereinafter JP '013) and No. 8-205014 (hereinafter JP '014), cited in Applicants' Supplemental IDS filed herewith, each describes an electronic still camera with a storage medium.

Japanese Patent Application KOKAI Publication No. 5-158778 (hereinafter JP '778), cited in Applicants' Supplemental IDS filed herewith, describes an information storage

device for storing image information in a recording medium where erase operations are controlled by the presence or absence of an erase-permission flag.

Japanese Patent Application KOKAI publication No. 7-143429 (hereinafter JP '429), cited in Applicants' IDS filed on February 19, 2002, describes dividing an image information recording area into a plurality of segments to store still images and gaining an access to the recording area from an image recording unit.

U.S. Patent No. 6,148,138, (Sawabe et al., hereinafter Sawabe), cited in the prosecution of Applicants' issued grandparent Ando '056 case and Applicants' Supplemental IDS filed herewith, discloses an information recording medium comprising a plurality of processed partial record information pieces, each corresponding to a predetermined reproduction time interval, and search reproduction control information including (a) time information indicating a reproduction time when each of the processed partial record information pieces is to be reproduced and (b) search information indicating addresses of other processed partial record information pieces, wherein the processed partial record information pieces and the search reproduction control information are multiplexed in order to form a plurality of multiplexed partial record information, wherein at least one of the multiplexed partial record information includes video information containing still picture information which is a subject to still picture reproduction, and wherein in a case when the reproduction time during which the still picture reproduction is to be performed is included in the predetermined reproduction time interval, the multiplexed partial record information corresponding to the reproduction time of the still picture reproduction contains no video information.

U.S. Patent No. 5,712,947, (Oguro et al., hereinafter Oguro), cited in the prosecution of Applicants' issued grandparent Ando '056 case and in Applicants' Supplemental IDS filed herewith, discloses a method of recording identification signals on a recording medium for

retrieving static video frames during a quick search operation from among static and dynamic video frames stored in recording portions on the recording medium, the quick search operation being conducted more quickly than a normal mode search and comprising the steps of: (a) recording for a first predetermined time a first identification signal identifying a plurality of the static and dynamic video frames in the recording portions which include a static video frame, wherein the first predetermined time is sufficient to allow detection of the first identification signal during the quick search operation; (b) selecting a desired static video frame from among the static and dynamic video frames recorded in a respective recording portion of the recording portions; (c) implanting, for a second predetermined time shorter than a sufficient time to allow detection during the quick search operation, into the respective recording portion subsequent to the recording of the recording portions, a second identification signal identifying the desired static video frame; and (d) retrieving the desired static video frame by detecting the first identification signal corresponding to the respective recording portion during the quick search operation, detecting thereafter the second identification signal corresponding to the desired static video frame, and reproducing the desired static video frame identified by the second identification signal.

U.S. Patent No. 5,678,160 (Aotake et al., hereinafter Aotake), cited in the prosecution of Applicants' issued parent Ando '702 case and in Applicants' IDS filed on February 19, 2002, discloses an information recording medium configured to contain a plurality of items composed of at least one of video information and audio information and playback control information for controlling the reproduction of the items recorded thereon, wherein the playback control information is comprised of a plurality lists and wherein at least one of the lists includes an item information indicating at least one item reproduced in accordance with the lists and a pointer representing an offset from a leading end of the playback control information indicating a separate list connected to the lists. Aotake also discloses a recording

medium having data recorded thereon, wherein the reproduction of the recording medium is controlled in accordance with lists having pointers, the recorded data comprising a plurality of items of audio and video data, a first playback list including an item information which indicates an address of an item of audio and video data, and including a list pointer which indicates an address of a list, a second playback list including an item information which indicates an address of an item of audio and video data, and including a list pointer which indicates an address of a list, and a selection list including an item information which indicates an address of an item of audio and video data, including a first playback list pointer which indicates an address of the first playback list, and including a second playback list pointer which indicates an address of the second playback list.

U.S. Patent No. 5,731,852 to Lee, cited in the prosecution of Applicants' issued parent Ando '702 case and in Applicants' IDS filed on February 19, 2002, discloses an image/audio information recording and reproducing apparatus that includes a semiconductor memory, a signal processor for processing image and audio information so that the image and audio information can be recorded on and reproduced from the semiconductor memory, and a control portion coupled between the semiconductor memory and the signal processor so as to store individual image information and individual audio information corresponding to the individual image information in the semiconductor memory as well as to read the stored image and audio information from the semiconductor memory using a start address of the individual information and both a start address and an end address of the individual audio information.

U.S. Patent No. 6,067,400 (Saeki et al., hereinafter Saeki), cited in the prosecution of Applicants' issued parent Ando '702 case and in Applicants' IDS filed on February 19, 2002, discloses methods and apparatuses associated with a multimedia optical disc comprising a data area for storing at least one object that has sub-picture data and moving picture data,

wherein the data area includes a plurality of small areas, each of which includes a first sub-area and a second sub-area, with the object in the data area being stored over consecutive small areas, where (a) the first sub-area stores moving picture data having a certain time period and sub-picture data being reproduced at the same timing as the moving picture data, the sub-picture data being a menu image which includes a plurality of buttons for showing menu items for display, and (b) the second sub-area stores control information including button control data for responding to a user's operation applied onto a menu image reproduced in the first sub-area in the same small area and auxiliary control data for substituting the user's operation applied onto the menu.

U.S. Patent No. 6,185,365B1 (Murase et al., hereinafter Murase), cited in the prosecution of Applicants' issued parent Ando '702 case and in Applicants' IDS filed on February 19, 2002, discloses an optical disk comprising a data region for storing a plurality of video sequences composed from a plurality of video segments, and a management information region for storing (a) a plurality of sequence information which indicates: (a1) a reproduction order of video segments included in each video sequence and (a2) positions on the optical disk of the video segments included in each video sequence, and (b) sequence-link information which indicates which one of two or more video sequences follows each video sequence depending on a value of a reproduction apparatus's register, wherein at least one of the video segments includes control command information which enables the value of the reproduction apparatus's register to be updated, and the control command information includes: a register information indicating one of the reproduction apparatus registers, an immediate value information indicating a predetermined value, condition information indicating a comparison expression of a value indicated by the immediate value information to a value of the register indicated by the register information, and link information indicating

video sequences to be reproduced when a comparison expression indicated by the current condition information is true.

Applicants respectfully submit that none of the above-discussed prior art references cited in the related U.S. and Japanese searches, individually or in combination, teach or suggest the apparatus or methods of the present invention, namely an information storage medium for use with at least one of a data recording device and a playback device, the information storage medium comprising:

“...at least one first information unit configured to store at least one piece of still picture information and control information corresponding to one still picture; and

 a first group unit configured to store information corresponding to at least one of said at least one first information unit, said one piece of still picture information being recorded in said first group unit,...”

let alone control information which includes at least one search pointer (S_VOGI_SRP) describing a start address of video object group information (S_VOGI) and at least one video object information for picture object (S_VOGI), where video object information for picture objects (S_VOGI) includes a still picture video object entry (S_VOB_ENT) which contains information for accessing objects including pictures, while the video object information for picture objects (S_VOGI) includes information of an address of a first still picture (S_VOG_SA) and a size of a picture. Hence, Applicants submit the present invention is patentably distinguishing over these references.

III. Conclusion

Applicants respectfully submit this Petition to Make Special meets all the requirements of MPEP § 708.02(VIII). Accordingly, Applicants respectfully request that this Application be advanced out of turn for examination, and that the assigned Examiner, pursuant to the suggestions of MPEP § 708.02 (VIII), contact the undersigned attorney to schedule an interview for advancing the prosecution in this case.

Respectfully submitted,

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